

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the following discussion, is respectfully requested.

Claims 1, 3, and 4-10 are currently pending. Claim 2 was canceled in a previous response. No claims are amended or newly added.

In the outstanding Office Action, Claims 1 and 3 were rejected under 35 U.S.C. §103(a) as unpatentable over Johnson (U.S. Patent No. 1,891,989, hereafter "Johnson") in view of Andler (U.S. Patent No. 2,368,911, hereafter "Andler") and Pindek (U.S. Patent No. 2,186,809, hereafter "Pindek"); and Claim 4 was rejected under 35 U.S.C. § 103(a) as obvious over Johnson in view of Andler and Pindek and further in view of Brozek (U.S. Patent No. 2,267,370, hereafter "Brozek").

Regarding the rejection of Claims 1 and 3, that rejection is respectfully traversed by the present response on the grounds that one of ordinary skill in the art would not have found it obvious to combine the cited references in such a way as to produce the invention recited in the claims. The rejection of Claim 4 as obvious over Johnson in view of Andler and Pindek and further in view of Brozek is traversed on the same grounds.

Claim 1 recites:

A zip fastener device configured to join two strips comprising two rows of teeth configured to mutually engage with each other under the action of a slider and applied respectively to one of the edges of each of the two strips, the material of the two strips being leather or simulation leather, wherein the two strips are formed by a piece folded in two, an area forming a fold is filled longitudinally with a rod of chosen thickness, and the teeth are applied at least partially around the fold area thus filled, wherein the zip fastener forms a wall of an article on which the zip fastener is disposed.

Accordingly, a wall of an article of clothing made of material such as leather is folded over a rod. The teeth attach at least partially around the fold. One benefit of this arrangement is that clothing made of relatively thick material can be used with zip fasteners, even if the

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material thickness is uneven.¹

The outstanding Office Action acknowledges that no reasonable combination of Johnson with Andler discloses that a zip fastener forms a wall of an article on which the zip fastener is disposed.² For this feature, the outstanding Office Action relies on Pindek. However, Pindek does not disclose that the teeth are attached to a folded area filled by a rod. Instead, Pindek describes either "a fabric formed with a corded edge" or "a seamed or folded edge."³ Accordingly, Pindek does not disclose filling a fold with a rod as recited in Claim 1.

The outstanding Office Action has not pointed to evidence in the record for any motivation to modify the "corded edge" or seamed or folded edge" of Pindek to incorporate an altered version of the double ply tape having a beaded edge"⁴ of Andler or the stringer of Johnson such that the folded, rod-filled wall recited in Claim 1 would be the result. Nor has the outstanding Office Action pointed to any evidence of a motivation to combine Brozek, cited the rejection of Claim 4, with Johnson, Andler and Pindek so as to include all of the features of dependent Claim 4. Rather, the outstanding Office Action merely states:

[a]s it would have been beneficial in the construction of Johnson to quickly form the beaded edge, it would have been obvious to utilize a beaded cord as a rod to form the beaded edge as taught by Andler to be useful to quickly form the beaded edge in conjunction with adhesively securing the folded strips together and further utilize the structure to form the wall of an article without a tape as taught to be a useful construction by Pindek, who finds such to be a principle advantage.⁵

However, Applicant respectfully submits that whether it would have been "beneficial" to modify the above references to include all of the features of Claim 1 is not the proper standard for determining obviousness. Rather, as stated in MPEP § 2143, the standard is as follows:

¹ Specification at 1, lines 11-16.

² Outstanding Office Action at 3, lines 7-10.

³ Pindek, col. 2, lines 9-16.

⁴ Andler, col. 2, lines 20-30.

⁵ Outstanding Office Action at 3, lines 11-15.

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To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

(Emphasis added). Thus, as the outstanding Office Action has pointed to nothing in the references themselves or elsewhere in the record indicating a motivation to combine the cited references in a manner such that the invention of independent Claims 1 or 4 would be the result, Applicant respectfully submits that the outstanding Office Action has not satisfied the burden under § 2143 for a *prima facie* case of obviousness.

Furthermore, none of the cited references discusses the problem of attaching zip fasteners to materials of irregular thickness. In other words, none of the cited references discloses a "beneficial" effect of allowing material which varies in thickness to be directly attached to zip fasteners, and the outstanding Office Action has pointed to no substitute motivation within the references or elsewhere in the record to modify the cited references so as to include all of the features of Claim 1.

In effect, the outstanding Office Action does little more than attempt to show that parts of the inventive combination of Claim 1 were individually known at the time the invention was made and to suggest that such a showing is all that is necessary to establish a valid case of *prima facie* obviousness. The PTO reviewing court recently reviewed such a rationale and dismissed it in *In re Rouffet*, 149 F. 3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) as follows:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all,

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inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

(Emphasis added).

There has been no such showing of those required reasons made in the final rejection. In fact, Pindek teaches away from combination with each of Johnson, Andler, and Brozek. See In re Ehrreich 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.

Each of Johnson, Andler, and Brozek requires an intermediate strip of material as a bridge between the teeth of the zip fastener and the wall of the garment or bag etc.⁶

In describing the arrangement of the fastener and fabric material, Pindek states that one advantage of its invention is that the fastening device may be made inconspicuous.⁷ Therefore, Pindek attaches its zip fastener directly to the wall of the garment instead of using conspicuous strips such as described in Johnson, Andler, and Brozek.

⁶ Johnson, col. 2, lines 69-76; Andler, col. 1, lines 17-42; Brozek, col. 2, lines 16-22.

⁷ Pindek, col. 3, lines 35-37.

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Pindek further states that another of its advantages is to attach a fastener to an article without an intermediate material strip (such as those of Johnson, Andler, and Brozek).

Pindek states:

From the forgoing it will be seen that the present invention has many advantages over the fasteners now on the market. **Principally among these may be mentioned that the interlocking members may be placed directly on the articles without an intervening tape, as is now the case...**⁸

(Emphasis added). Accordingly, Pindek specifically notes that its principal advantage is the omission of the intervening tape such as that required by Johnson, Andler, and Brozek. In other words, an attempt to bring the isolated teaching of Pindek's fastener attached directly to the wall material into the zip fasteners attached to intervening material strips required by Johnson, Adler, and Brozek would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.

Thus, Applicant respectfully submits that no reasonable combination of Johnson, Andler and Pindek includes all the features recited in Claim 1 or Claim 3 depending therefrom and that no reasonable motivation to combine teachings from the references has been presented. Nor does any reasonable combination of Johnson, Andler, Pindek and Brozek include all of the features of dependent Claim 4. Further, the required showing as to reasonable motivation leading to any combination of these references is also lacking.

Accordingly, Applicant respectfully requests that the rejection of Claims 1, 3, and 4 be withdrawn.

⁸ Pindek, col. 3, lines 50-55.

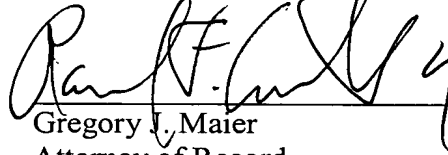
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UNDER 37 C.F.R. § 1.116-
EXPEDITED PROCEDURE EXAMINING
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Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully submitted,

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A handwritten signature in black ink, appearing to read 'Gregory J. Maier', is written over a horizontal line.

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